

FILE COPY

Office - Supreme Court, U.
FILED
APR 21 1949
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term 1948

No. [REDACTED]

747

STANDARD BRANDS INCORPORATED and CAMP-
BELL SOUP COMPANY, Successor thereto and Inter-
vening Plaintiff,

Petitioners,

against

EASTERN SHORE CANNING COMPANY,
INCORPORATED,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO
THE COURT OF APPEALS FOR THE
FOURTH CIRCUIT**

ELLIS W. LEAVENWORTH,
Counsel for Petitioners.



INDEX

	PAGE
PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE FOURTH CIRCUIT	1
Summary Statement of the Matter Involved	2
Jurisdiction	4
The Questions Presented	4
Reasons Relied on for the Allowance of the Writ ..	5
SUPPORTING BRIEF	7
Opinions of the Courts Below	7
Jurisdiction	7
Statement of the Case	7
Specification of Errors	8
ARGUMENT	10
I. The Court of Appeals for the Fourth Circuit has rendered a decision in conflict with the decision of the Court of Appeals for the Second Circuit in <i>Standard Brands Inc. v. Smidler</i> , 151 F. (2d) 34	10
II. The Court of Appeals for the Fourth Circuit has decided three important questions under the Trade-Mark Act which have not been, but should be, settled by this Court	16
1. In deciding whether the accused mark is a "colorable imitation" of the mark alleged to be infringed, should the court take into consideration the accessories used with the accused mark such as the name of the defendant on the label and the appearance of the label as a whole?	17

	PAGE
2. Is there any basis in law or common knowledge for a finding that people familiar with the trademark alleged to be infringed have knowledge of the identity of the owner thereof and would not be confused by the accused mark unless they thought it indicated the goods of a party of that identity?	20
3. Is it significant that the defendant's kind of goods would not be mistaken for the plaintiff's kind of goods in a case where the goods of the parties are related but not identically the same?	23
CONCLUSION	25

Table of Cases

Aunt Jemima Mills Co. v. Rigney (C. A. 2) 247 Fed. 407	13
Bayer Co. v. United Drug Co., 272 Fed. 505	22
Beech-Nut Co. v. Lorillard Co., 273 U. S. 629	24
Champion Plug Co. v. Sanders, 331 U. S. 125	16
Coty v. Le Blume Import Co. (S. D. N. Y.) 292 Fed. 264	22
Dawes and Fanning (1872), 1 Official Gazette 27	22
Dennison Mfg. Co. v. Thomas Mfg. Co. (Del.) 94 Fed. 651	22
Gehl v. Hebe Co. (C. A. 7) 276 Fed. 271	18
Grove Laboratories v. Brewer & Co. (C. A. 1) 103 F. (2d) 175	19
Hanover Star Milling Co. v. Metcalf and Allen & Wheeler Co. v. Hanover Star Milling Co., 240 U. S. 403	10

	PAGE
La Touraine Coffee Co. v. Lorraine Coffee Co. (C. A. 2)	
157 F. (2d) 115	23
Mishawaka Mfg. Co. v. Kresge Co., 316 U. S. 203 . .	16, 25
N. K. Fairbank Co. v. Luckel, King & Cake Soap Co.	
(C. A. 9) 102 Fed. 327	18
Powell v. Birmingham Vinegar Brew. Co., 66 L. J. Ch.	
763	21
Pro-phy-lac-tic Brush Co. v. Lawson (1937) 32 U. S.	
P. Q. 262	22
Reid Murdoch & Co. v. H. P. Coffee Co. (C. A. 8) 48	
F. (2d) 817	18
Restatement of Torts, §729	18
Rice-Stix v. Industrial (C. C. P. A.) 152 F. (2d) 1011	18
Saalfeld Pub. Co. v. G. & C. Merriam Co. (C. A. 6) 238	
Fed. 1	21
Shaver v. Heller & Merz Co. (C. A. 8) 108 Fed. 821 . .	22
Standard Brands Inc. v. Smidler, 151 F. (2d) 34 . .	5, 10, 19
Tillman & Bendel v. California Packing Corp. (C. A. 9)	
63 F. (2d) 498	18
35 Trade-Mark Reporter 103, Part I	15
Walter Baker & Co. v. Slack (C. A. 7) 130 Fed. 514 . .	21



IN THE
Supreme Court of the United States

October Term 1948

No.

—o—

STANDARD BRANDS INCORPORATED and CAMPBELL SOUP
COMPANY, Successor thereto and Intervening Plaintiff,
Petitioners,

against

EASTERN SHORE CANNING COMPANY, INCORPORATED,
Respondent.

—o—

**PETITION FOR A WRIT OF CERTIORARI TO
THE COURT OF APPEALS FOR THE
FOURTH CIRCUIT**

To the Honorable, the Chief Justice and Associate Justices
of the Supreme Court of the United States:

Your petitioners Standard Brands Incorporated and
Campbell Soup Company pray for a writ of certiorari to
the United States Court of Appeals for the Fourth Circuit
to review a final judgment of that court entered January
22, 1949 affirming a judgment of the District Court for the
Eastern District of Virginia (Judge Paul).

The opinion of the Court of Appeals is reported at
172 F. (2d) 144 and appears at page 38 of the record. The
District Court opinion (R. 20) has not been reported.

Summary Statement of the Matter Involved

Despite diversity jurisdiction, Standard Brands Incorporated, a Delaware corporation, brought this action specifically under the Trade-Mark Act of 1905 (Sections 16 *et seq.*, 15 U. S. C. §§96 *et seq.*) against Eastern Shore Canning Company, Incorporated, a Virginia corporation, charging infringement of the trademark V-8 for a vegetable juice cocktail by the unauthorized trademark use of VA on tomato juice and lima beans. The defendant is described as "a small Virginia corporation" in the answer (R. 7) and the opinion of the District Court (R. 21), and the plaintiff is described as "a corporation of nation wide fame" in the opinion of the Court of Appeals (R. 42). The complaint contains the usual allegation of unfair competition but no acts of unfair competition are specified excepting the alleged trademark infringement.

Standard Brands had agency offices in seven cities of Virginia. Its V-8 trademark had not only been registered under the federal Act of 1905 and nationally used and advertised, but had also been extensively used, advertised and registered in Virginia, before respondent made any VA trademark use.

Photographs of cans of the V-8 Vegetable Juice Cocktail (Exhibit B) and VA Tomato Juice (Exhibit H) are shown on the next two pages. These particular cans were physical exhibits before the courts below and are available for submission to this Court (R. 11, 13, 43).



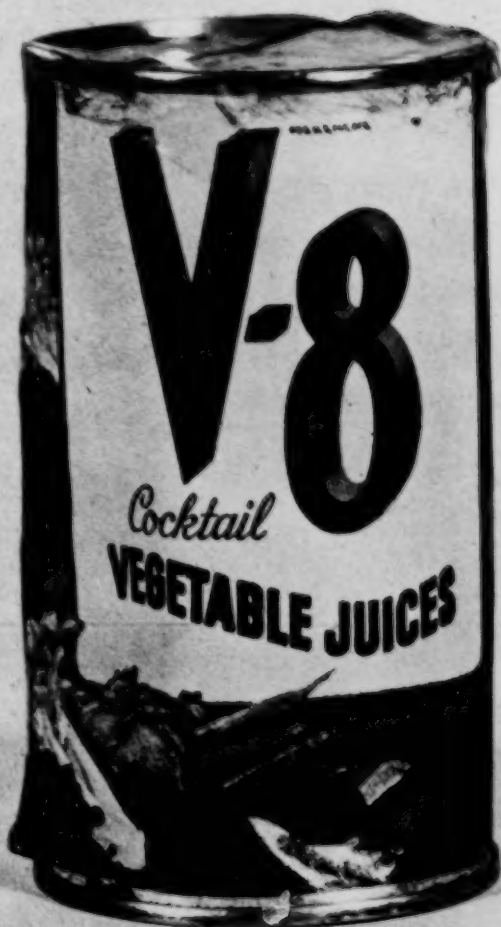


EXHIBIT B



EXHIBIT H



The case was tried upon a stipulation of facts and accompanying exhibits. There were no witnesses. The Court of Appeals, however, seems to have applied the rule (R. C. P. 52a) that "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses". The court held that the crucial question of likelihood of confusion "must be left to the determination of the trier of fact" (R. 42).

Although V-8 and VA are not unlike in appearance, and the courts below found them phonetically alike, and both are applied to tomato juice (although the V-8 product contains other vegetable juices which do not change the tomato juice color of it), the District Court held there was no likelihood of confusion and the Court of Appeals affirmed.

While the case was pending in the District Court, Campbell Soup Company, a New Jersey corporation, purchased the trademark V-8 from Standard Brands and was allowed to intervene.

The Trade-Mark Act of 1905 was repealed and supplanted by the Act of 1946 effective July 5, 1947 (15 U. S. C. §§1051-1127) which provided in section 46 (a) that "This Act * * * except as otherwise herein specifically provided shall not affect any suit * * * then pending" (15 U. S. C. §1051 note). It provided in section 46 (b), however, that registrations under the Act of 1905 "shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal

register established by this Act except as limited" in sections not here involved (15 U. S. C. §1051 note).

Section 32 (1) of the Act of 1946 (15 U. S. C. §1114) codifies the case law construing sections 16 and 19 of the Act of 1905 (15 U. S. C. §§96, 99) in so far as they defined trademark infringement. The questions here presented involve the construction and enforcement of sections 16 and 19 of the Act of 1905 and 32 (1) of the Act of 1946.

Jurisdiction

The date of the judgment of the court below is January 22, 1949 (R. 43).

The jurisdiction of this Court is invoked under Sections 1254 (1) and 2101 of Title 28, and Section 1122 of Title 15, United States Code.

The Questions Presented

1. In deciding whether VA is a "colorable imitation" of V-8, should the court have taken into consideration the accessories used with VA such as the name of the defendant on the label and the appearance of the label as a whole?

2. Is there any basis in law or common knowledge for a finding that people familiar with the trademark V-8 have knowledge of the identity of the owner thereof and would not be confused by VA unless they thought it indicated the goods of a party of that identity?

3. Is it significant in this case that tomato juice or lima beans would not be mistaken for a vegetable juice cocktail?

4. Is the use of VA on tomato juice and lima beans in the manner and form shown on Exhibit H "likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods" (15 U. S. C. §1114) by causing purchasers to believe that such goods come from the same source as the V-8 Vegetable Juice Cocktail?

Reasons Relied on for the Allowance of the Writ

I. The Court of Appeals for the Fourth Circuit has rendered a decision in conflict with the decision of the Court of Appeals for the Second Circuit in *Standard Brands Inc. v. Smidler*, 151 F. (2d) 34.

II. The Court of Appeals has decided three important questions under the Trade-Mark Act which have not been, but should be, settled by this Court:

1. In deciding whether the accused mark is a "colorable imitation" of the mark alleged to be infringed, should the court take into consideration the accessories used with the accused mark such as the name of the defendant on the label and the appearance of the label as a whole?

2. Is there any basis in law or common knowledge for a finding that people familiar with the trademark alleged to be infringed have knowledge of the identity of the owner thereof and would not be confused by the accused trademark unless they thought it indicated the goods of a party of that identity?

3. Is it significant that the defendant's kind of goods would not be mistaken for the plaintiff's kind of goods in a case where the goods of the parties are related but not identically the same?

WHEREFORE your petitioners respectfully pray that a writ of certiorari may issue to the United States Court of Appeals for the Fourth Circuit commanding the said court to certify and send to this Court a full and complete transcript of the record and all proceedings of the said court in the case numbered and entitled on its docket No. 5816, *Standard Brands Incorporated and Campbell Soup Company, Successor thereto and Intervening Plaintiff, Appellants, v. Eastern Shore Canning Company, Incorporated, Appellee*, to the end that this case may be reviewed and determined by this Court, that the judgment of said Court of Appeals herein may be reversed and that your petitioners may have such other and further relief as may be just.

April 19, 1949.

ELLIS W. LEAVENWORTH,
Counsel for Petitioners.

IN THE
Supreme Court of the United States

October Term 1948

No.

STANDARD BRANDS INCORPORATED and CAMPBELL SOUP
COMPANY, Successor thereto and Intervening Plaintiff,
Petitioners,

against

EASTERN SHORE CANNING COMPANY, INCORPORATED,
Respondent.

SUPPORTING BRIEF

Opinions of the Courts Below

The District Court's opinion (R. pp. 20-30) is not reported. The opinion of the Court of Appeals (R. pp. 38-42) is reported 172 F. (2d) 144, and 80 U. S. P. Q. 318.

Jurisdiction

The date of the judgment of the court below is January 22, 1949 (R. 43) and the grounds on which jurisdiction is invoked are stated in the petition at page 4.

Statement of the Case

The essential facts are stated in the petition at page 2.

Specification of Errors

The Court of Appeals for the Fourth Circuit erred:

1. In deciding the case upon the basis of a comparison of the labels instead of the trademarks of the parties.

2. In resorting to one of the accessories used on the VA label, to wit, the name of the respondent, in order to find that VA is a geographical term and indicates territorial origin and not commercial origin.

3. In concluding that accessories used by the respondent in connection with the VA, such as the design and colors of the VA labels and the name of the respondent, are relevant and material in this case; and in failing to conclude that they are not relevant or material.

4. In finding that VA is customarily used as an abbreviation of the name of the state of Virginia, and in failing to find that VA is customarily used as an abbreviation of the name Veterans' Administration.

5. In failing to make any finding whatsoever with respect to the impression likely to be conveyed to prospective purchasers by the VA, in and of itself, when used in the manner and form in which it is used on the VA labels.

6. In failing to find that the VA is used on respondent's labels in the manner and form of a trademark and is likely to convey to prospective purchasers the impression that it indicates commercial origin and not geographical origin.

7. In finding that the VA on respondent's label would be understood as indicating a Virginia product "rather

than the goods of a corporation of nation wide fame", and in thereby finding in effect that people familiar with the trademark V-8 have knowledge of the identity of the owner thereof and will not be confused by VA unless they think it indicates the goods of a party of that identity.

8. In concluding that it is material that there would be no confusion of goods as distinguished from confusion of source, and in failing to conclude that the lack of confusion of goods is immaterial in a case such as this where the complaint is based on alleged confusion of source without confusion of goods.

9. In concluding that the crucial question of likelihood of confusion "must be left to the determination of the trier of fact", although there were no witnesses and the Court of Appeals was under no duty to give due regard to the opportunity of the trial court to judge of the credibility of witnesses.

10. In concluding that close phonetic similarity is not sufficient in itself to cause confusing similarity of trademarks.

11. In failing to make any finding as to the visual similarity between VA and V-8.

12. In failing to find that VA and V-8 are similar in appearance and that the total of the similarities in sound and appearance is sufficient to be likely to cause confusion.

13. In failing to find that tomato juice, lima beans and a vegetable juice cocktail are so closely associated in the minds of purchasers of such products that they are likely

to be regarded as coming from the same source if sold under confusingly similar trademarks.

14. In failing to find that VA Tomato Juice and VA Lima Beans are likely to be regarded as coming from the same source as the V-8 Vegetable Juice Cocktail.

15. In affirming the judgment of the District Court.

ARGUMENT

The points of the argument are stated in the petition at page 5 as reasons relied on for the allowance of the writ.

I. The Court of Appeals for the Fourth Circuit has rendered a decision in conflict with the decision of the Court of Appeals for the Second Circuit in *Standard Brands Inc. v. Smidler*, 151 F. (2d) 34.

The two decisions are in conflict on the question of the extent of the V-8 trademark rights with reference to the kind of goods. The situation is similar to that presented in *Hanover Star Milling Co. v. Metcalf* and *Allen & Wheeler Co. v. Hanover Star Milling Co.*, 240 U. S. 403, where certiorari was granted to the Court of Appeals for the Fifth Circuit and the Court of Appeals for the Seventh Circuit because "These courts differed upon fundamental questions" (p. 408) and "Interesting and important questions are raised concerning the territorial extent of trade-mark rights" (p. 411). The trademark TEA ROSE was involved in both cases.

The question of the extent of trademark rights with reference to the kind of goods would seem to be even more fundamental and important than the question of their extent territorially because it relates to the scope of the substantive rights in all territories. The Second Circuit held that the V-8 trademark rights extend to such products as a manufacturer of food might reasonably be expected to manufacture, and that such products include vitamin tablets (151 F. (2d) 34, 36, 37):

“The defendant’s dry vitamin tablets are very different in appearance and however marked could not be mistaken by anyone for liquid vegetable juice, but that fact is a colorless one. * * * They are eaten with food and are widely represented to supplement it by the addition of properties essential to health in which the diet of the user may be deficient for one reason or another. It might reasonably be expected that a manufacturer or distributor of food would also make or distribute vitamin tablets. Indeed, it does appear, as already noted, that this plaintiff produces and distributes dry vitamin tablets under the mark ‘Stams’.”

The Fourth Circuit held, however, that the V-8 trademark rights do not extend to tomato juice and lima beans because those products could not be mistaken for vegetable juices (R. 42):

“It is significant * * * that V-8, as used by the plaintiff, has become associated in the public mind with a specific combination of vegetable juices; that defendant does not manufacture this product and has used its accused mark only on products which no one would mistake for the combination * * *.”

The Fourth Circuit *stated* the law of the *Smidler* case (and the established federal law on the subject) as follows (R. 42):

“And it is also well established that the protection which the law gives to the owner of a trade-mark is not confined to the goods upon which it has been used by the owner, but extends to products which would be reasonably thought by the buying public to come from the same source if sold under a similar mark. *Standard Brands Inc. v. Smidler*, 2 Cir., 151 F. 2d 34, 36; *Restatement of Torts*, §728, Comment c, §730.”

But having stated the law, the Fourth Circuit not only failed to apply it but took from the discussion of another point in the *Smidler* opinion (whether V-8 is a valid trade-mark) the thought that V-8 “has become associated in the public mind with a specific combination of vegetable juices” and misapplied it in support of the statement quoted *supra* that it is significant that no one would mistake the products of the defendant for vegetable juices. The phrase “associated in the public mind” was used by the Second Circuit in a discussion of the validity of the trademark V-8 (not here involved) which is quoted in part by the Fourth Circuit (R. 39) and continues as follows (151 F. (2d) 34, 36):

“Except for this association, we think, no one could reasonably be expected to know that ‘V-8’ designated a vegetable juice cocktail, or any other particular thing for that matter, unless it be something so described by both shape and number, like an eight cylinder automobile engine, for instance, having cylinder blocks set at an acute angle to each other.”

" The facts relating to the extent of the V-8 trademark rights with reference to the kind of goods in these two cases are facts to which the same law is applicable and should have been applied. The goods of the defendants in the two cases are not the same but in the *Smidler* case the defendant's goods were not so closely associated with the plaintiff's goods as in this case where not only are the goods of both parties food products but defendant's tomato juice resembles plaintiff's vegetable juices in appearance as the court below found (R. 39) and is put to the same use, so that both products are in fact a vegetable juice cocktail.

In the *Smidler* case, Standard Brands made and sold vitamin tablets but used a different trademark thereon. In this case it makes and sells tomato juice and lima beans but uses a different trademark thereon (R. 16). In both cases the trial and appellate courts noted this factual similarity. On this factual foundation, infringement is found in the *Smidler* case and not found in this case. The explanation for the divergence is precisely stated in the *Smidler* case at page 37:

"The gist of this action for infringement of the plaintiff's mark, just as in the related cause of action for unfair competition, is *confusion not as to the kind of product but as to the source of the product.*"

That rule stems from the pancake flour and maple syrup case, *Aunt Jemima Mills Co. v. Rigney*, 247 Fed. 407, 409-410, C. A. 2. It has been followed in other circuits and accepted by Congress and codified in the Trade-Mark Act of 1946, Sec. 32 (1), 15 U. S. C. §1114 (1):

“Any person who shall * * * use, without the consent of the registrant, any * * * colorable imitation of any registered mark in connection with the sale * * * of any goods * * * on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of the origin of such goods * * * shall be liable * * *.”

This language is a sharp departure from the corresponding provision of the Trade-Mark Act of 1905, Sec. 16, 15 U. S. C. §96:

“Any person who shall, without the consent of the owner thereof, * * * colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration * * * and shall use * * * such * * * colorable imitation in commerce * * * shall be liable * * *.”

Judge Veeder who was reversed in the *Aunt Jemima* case, said (234 Fed. 804, 808):

“No one desiring to purchase flour would accept syrup without knowing the difference. That is the test”.

That is the kind of statement that the court below made in this case on January 22, 1949, although the Act of 1946 became effective July 5, 1947:

“It is significant * * * that defendant does not manufacture this product [combination of vegetable juices] and has used its accused mark [VA] only on products [tomato juice, lima beans] which no one would mistake for the combination” (R. 42).

This is a reversion to the view expressed in 1916 by the District Court in the *Aunt Jemima* case.

The contrary view, confusion not as to goods but as to origin of goods, has been applied very generally outside of the Fourth Circuit, was applied in the *Smidler* case and has been codified as statute law in the 1946 Act for the guidance of all federal courts.

The importance of the question of the extent of trade-mark rights with reference to the kind of goods is indicated by Judge Frank's "concurring" opinion in the *Smidler* case, 151 F. (2d) at 37-43. After criticizing the *Aunt Jemima* case on the last page (par. 4), he states at the end that he concurs with his colleagues and adds "I would not, however, be sorry if the Supreme Court reversed our decision". No petition was filed in that case.

It is also indicated by the editorial comment on Judge Frank's opinion in the *Trade-Mark Reporter* for September 1945 under the heading "The extent of a trade-mark owner's rights with reference to the kind of goods" (35 T. M. R. 103, Part I).

II. The Court of Appeals for the Fourth Circuit has decided three important questions under the Trade-Mark Act which have not been, but should be, settled by this Court.

In *Mishawaka Mfg. Co. v. Kresge Co.*, 316 U. S. 203, the reasons for granting certiorari were stated by Mr. Justice Frankfurter as follows (204):

“Deeming the matter to present an important question under the Trade-Mark Act, we brought the case here solely to review the provisions of the decree dealing with the measure of profits and damages for the infringement found by the two lower courts”.

In *Champion Plug Co. v. Sanders*, 331 U. S. 125, another question relating to remedies for trademark infringement was taken up and settled by this Court, namely, the question whether the Trade-Mark Act requires that an accounting be ordered where an injunction will satisfy the equities of the case.

The questions here presented relate to the liability instead of the remedies for infringement, and although this Court has settled many important questions of general application in that connection (such as those relating to generic terms, surnames, abandonment and territorial limitation of trademark rights), the Court has apparently never reviewed certain fundamental rules that are applied as measuring rods by the lower federal courts in determining infringement liability. The measure of such liability in the Court of Appeals for the Fourth Circuit and the district courts of the five states in that circuit should be the same as in the rest of the United States if the Trade-Mark Act is to be effectively enforced with respect to inter-state commerce.

1. In deciding whether the accused mark is a "colorable imitation" of the mark alleged to be infringed, should the court take into consideration the accessories used with the accused mark such as the name of the defendant on the label and the appearance of the label as a whole?

The Court of Appeals found (R. 42):

"* * * the letters VA are customarily used as an abbreviation of the name of the state in which the defendant produces and distributes its goods, and *when used in connection with defendant's name which includes the well known designation of a geographical subdivision of the state, would be understood as indicating the territorial origin of the product* * * *."¹

In so finding the court resorted to the defendant's name, one of the accessories used by the defendant in connection with the accused mark, in order to find that the accused mark conveys a geographical meaning and indicates territorial origin instead of commercial origin.

This was fundamental error. It ignores basic concepts as to what constitutes confusing similarity of trademarks, or in the language of the statute, "colorable imitation of any registered mark" (Act of 1946 §32 (1); 15 U. S. C. §1114), and as to the facts that are relevant to that issue.

The accused mark must stand on its own feet and be sufficiently different in itself from the plaintiff's trademark to avoid confusion. It may not depend upon extraneous matter which may or may not be read and remembered, and which may be changed from time to time. The accessories used on the defendant's label, including the name of the de-

¹ Italics in this brief are ours unless otherwise stated.

fendant, other wording on the label, and the design, colors and general appearance of the label, are not relevant.

N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (C. A. 9) 102 Fed. 327, 331, 332;

Tillman & Bendel v. California Packing Corp., (C. A. 9) 63 F. (2d) 498, 508, 509;

Rei. Murdoch & Co. v. H. P. Coffee Co., (C. A. 8) 48 F. (2d) 817, 818, 819;

Gehl v. Hebe Co., (C. A. 7) 276 Fed. 271, 272, 273;

Rice-Stix v. Industrial, (C. C. P. A.) 152 F. (2d) 1011, 1012.

The Restatement of Torts, §729, "Factors in Confusing Similarity" significantly omits accessories used with the marks involved.

The finding that the accused mark VA, when used with the defendant's name, indicates territorial origin is a finding that VA has a geographical meaning and therefore is not similar to V-8 in respect of the meaning of the two marks. Geographical meaning enters into this case only in connection with the question of confusing similarity as no question of the validity of the defendant's mark is involved. The elements of confusing similarity are similarities in appearance, sound and meaning and the plaintiff has contended that V-8 and VA are substantially identical in sound, not unlike in appearance, and not different in meaning because each is a symbol without any meaning.

The rule that accessories are irrelevant also applies to the issue of the validity of a trademark, where presented.

In *Standard Brands Inc. v. Smidler* (C. A. 2) 151 F. (2d) 34, *supra*, the court said (36):

“The letter V by itself no more signifies ‘vegetable’ than it does any other word of which it is the initial letter and *it is only when resort is had to other parts of the label* that one may glean that it stands for ‘vegetable’.”

To similar effect is *Grove Laboratories v. Brewer & Co.* (C. A. 1) 103 F. (2d) 175, 179.

With respect to the general appearance of the labels the Court of Appeals found (R. 40):

“The defendant does not display its trade-mark VA in such a way as to lead a purchaser to confuse it with V-8. On this point the District Judge made the following finding which is supported by the evidence:

“There is a marked difference in the appearance of the labels and trade-marks used by the respective parties, including their background, their coloring, and the arrangement of the printed matter thereon. Even the letters, or symbols, V-8 and VA, as printed on the labels, are decidedly unlike both in form and coloring. Neither the defendant’s VA tomato juice label nor its VA lima bean label bears such a resemblance to plaintiff’s V-8 label as would cause the ordinary shopper who might see them on the store shelf to mistake one for the other or to be in any way confused. The difference in appearance is such as to offer no suggestion that the products to which they are attached are from the same source or are put up by the same packer.’ ”

The District Judge decided the case mainly on the basis of the labels instead of the trademarks, much of his discussion being devoted to the "marked difference in the appearance of the labels as a whole" (R. 25, 26, 28, 29).

2. Is there any basis in law or common knowledge for a finding that people familiar with the trademark alleged to be infringed have knowledge of the identity of the owner thereof and would not be confused by the accused mark unless they thought it indicated the goods of a party of that identity?

The Court of Appeals found that the accused mark VA "would be understood as indicating the territorial origin of the product *rather than the goods of a corporation of nation wide fame*" (R. 42). This was in effect a finding that people familiar with V-8 have knowledge of the identity of the owner thereof and would not be confused by VA unless they thought it indicated the goods of a party of that identity.

There is no basis in the record for such a finding or in common knowledge. On the contrary it is a familiar fact that purchasers of trademarked products are not usually interested in the names of the producers. The trademarks serve as a convenient and adequate means of identification. Not only is the identity of the producer frequently unknown but the producer is frequently not interested in making it known. The trademark is substituted for the producer's name and functions more effectively in sales and advertising. In this case the V-8 labels and scrap book of advertisements (Exhibits A, B, F; R. 10, 11, 12) will show, if examined, how little was done to acquaint the public with the name of the producer.

Nor is there any basis in law for such finding or assumption. This was pointed out in an English case which has been frequently cited and followed in our federal courts (*Powell v. Birmingham Vinegar Brew. Co.*, 66 L. J. Ch. 763):

"I think that the fallacy of the appellants' argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case, it seems to me that 'Yorkshire Relish' means the manufacture of a particular person. I do not mean that in the minds of the public the name of the manufacturer was identified, but that it means a particular manufacture; * * *."

In *Walter Baker & Co. v. Slack* (C. A. 7) 130 Fed. 514, the court said (p. 518):

"We may safely take it for granted that not one in a thousand knowing of or desiring to purchase 'Baker's Cocoa' or 'Baker's Chocolate' know of Walter Baker & Co., Limited."

In *Saalfeld Pub. Co. v. G & C Merriam Co.* (C. A. 6) 238 Fed. 1, the court said (pp. 8, 9):

"Particularly under present-day conditions, the purchasing public may have a fixed purpose to buy a given article and not a substitute therefor, and yet be quite ignorant whether the genuine article is made

by one or another manufacturer. Even under earlier conditions, the purchaser of 'Stone Ale' or 'Camels' Hair Belting' or 'Glenfield Starch' very likely knew as little as he cared about the personal identity of the maker."

In the familiar *Aspirin* case, an action for infringement of a trademark registered under the Act of 1881 (which is on a par with the Act of 1905 under Sec. 46 (b) of the Act of 1946, 15 U. S. C. §1051 note), Judge Learned Hand said (*Bayer Co. v. United Drug Co.*, 272 Fed. 505, 509) :

"So here it might be that the name 'Aspirin' in fact had come at once to describe the drug in question and also its origin from a single source. If it did, that would be enough to justify some protection, since the identity of the source need not be known.
* * * So here the question is whether the buyers merely understood that the word 'Aspirin' meant this kind of drug, or whether it meant that and more than that; i.e., that it came from the same single, though, if one please anonymous, source from which they had got it before."

To similar effect are *Coty v. Le Blume Import Co.* (S.D.N.Y.) 292 Fed. 264, 267, 268; *Shaver v. Heller & Merz Co.* (C.A. 8) 108 Fed. 821, 824; *Dennison Mfg. Co. v. Thomas Mfg. Co.* (Del.) 94 Fed. 651, 656.

This has been Patent Office law since the first trademark case was decided there. *Dawes and Fanning* (1872), 1 Official Gazette 27, 28; *Pro-phy-lac-tic Brush Co. v. Lawson* (1937), 32 U. S. P. Q. 262.

3. Is it significant that the defendant's kind of goods would not be mistaken for the plaintiff's kind of goods in a case where the goods of the parties are related but not identically the same?

The Court of Appeals found (R. 42):

"It is significant * * * that V-8, as used by the plaintiff, has become associated in the public mind with a specific combination of vegetable juices; that defendant does not manufacture this product and has used its accused mark only on products which no one would mistake for the combination; * * *."

The fact that no one would mistake a product packed in a can labelled tomato juice or lima beans for a product packed in a can labelled vegetable juices is of no significance in this case. The question presented is not whether the defendant's kind of goods will be mistaken for the plaintiff's kind of goods (confusion of goods) but whether the defendant's kind of goods are "closely associated" with the plaintiff's kind of goods "in the minds of the purchasers of such products" (par. XI of the complaint, R. 3). The ultimate question as to whether the use of the accused mark of the defendant upon the kind of goods on which it is used "is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods" (Act of 1946 §32 (1), 15 U. S. C. §1114 (1); paragraph XII of the complaint, R. 3) does not depend on confusion of goods but on association of goods.

There are many cases where the goods of the parties are the same kind of goods so that confusion as to source is caused by confusion of goods. For example, in *La Touraine Coffee Co. v. Lorraine Coffee Co.* (C. A. 2) 157 F. (2d) 115, 117, confused purchasers would think that Lorraine Coffee comes from the same source as La Touraine

Coffee because they would think it is La Touraine Coffee. That, however, is not this case. A formula for all cases under the Trade-Mark Act would be that use of a colorable imitation of a registered mark on either the same kind of goods or associated kinds of goods results in confusion as to the source of origin of the goods. The court below correctly stated the law as to the extension of trademark rights to associated goods but failed to apply it (p. 13 *supra*).

Accordingly the case presents the question whether lack of confusion as to the kind of goods is basis for a finding that there is no likelihood of confusion as to the source of the goods under the Trade-Mark Act. This is important and does not appear to have been settled by this Court.

In *Beech-Nut Co. v. Lorillard Co.*, 273 U. S. 629, Mr. Justice Holmes cited two cases on the subject in stating the reasons for granting certiorari (p. 631), but expressed no opinion as to the effect of the differences in the kind of goods (ham, bacon, chewing gum, peanut butter, ginger ale *vs.* chewing tobacco) in view of a concession by the plaintiff (p. 632):

“It may be true that in a case like the plaintiff’s its rights would not be sufficiently protected by an injunction against using the marks upon goods of the same class as those to which the plaintiff now applies it and to which its registration is confined. Upon that we express no opinion. For when it is conceded that whatever its effect the defendant has a right to use ‘Beechnut’ on tobacco unless the right has been abandoned, that possibility does not matter.”

In *Mishawaka Mfg. Co. v. Kresge Co.*, 316 U. S. 203, the goods involved were rubber heeled shoes and detached rubber heels, the plaintiff's trademark having been registered for shoes, but Mr. Justice Frankfurter expressed no opinion as to the materiality of the fact that heels would not be mistaken for shoes because certiorari had been granted "solely to review the provisions of the decree dealing with the measure of profits and damages for the infringement found by the two lower courts" (pp. 204, 205).

Conclusion

The Court of Appeals ended its opinion with the following statement (R. 42):

"Against this factual array the phonetic similarity of the two marks cannot prevail, even if it be supposed, in the absence of any testimony on the point, that the defendant's goods are asked for as VA rather than Virginia tomato juice or lima beans."

The "factual array" is set out in the preceding sentence of the opinion and consists solely of the findings that have already been discussed.

The "phonetic similarity of the two marks" is apparent but the suggestion that defendant's goods may possibly be asked for as Virginia tomato juice or lima beans is not only inconsistent but difficult to understand.

There was no testimony as to the sound of VA when pronounced because all of the facts were stipulated at the suggestion of the defendant in order to save expense, and there is no stipulation on the point because there was and is no question as to what is the fact. VA is a symbol applied to a merchandise label and there can be no doubt as

to how it is pronounced. Defendant would not want it to be pronounced "Virginia" as it would be quite valueless to the defendant in that event. Defendant called it "the trade brand VA" in its answer and also stated that "The VA trade brands" (tomato juice and lima beans) "have become well established with its trade and are a valuable asset of its business" (R. 9). That certainly could not be true if they were so indistinctive as to be pronounced "Virginia".

In addition to the phonetic similarity there is a similarity in appearance between VA and V-8 and no difference in meaning because VA and V-8 are symbols which have no meaning by themselves.

The goods sold under the two marks are not only associated goods but defendant's tomato juice is substantially the same as plaintiff's vegetable juice cocktail from the trademark viewpoint (p. 13 *supra*). It is only the fact that the two products are packed in cans labelled with the respective product names that prevents them from being mistaken for each other.

The petitioners have a strong case on the merits. The decision below is in conflict with a decision in the Second Circuit on the same trademark and presents important questions which have not been but should be settled by this Court.

Respectfully submitted,

ELLIS W. LEAVENWORTH,
Counsel for Petitioners.

U.S. SUPREME COURT
FILED
MAY 21 1949
CHARLES ELMORE CROPLAND
CLERK

THE SUPREME COURT
of the
UNITED STATES

OCTOBER TERM 1948

No. 747

STANDARD BRANDS, INCORPORATED and
CAMPBELL SOUP COMPANY, Successor
thereto and Intervening Plaintiff,
Petitioners,

vs.

EASTERN SHORE CANNING COMPANY,
INCORPORATED,
Respondent.

BRIEF OF EASTERN SHORE CANNING COMPANY,
INCORPORATED, IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI

GEORGE M. LANNING,

BENJAMIN W. MEARS,

BARRON F. BLACK

Counsel for Respondent.

INDEX

	PAGE
Facts	1
Argument	3
I. There is no conflict between the decisions of the Court of Appeals for the Fourth Circuit in the instant case and that of the Court of Appeals for the Second Circuit in the Smidler case because the cases were decided on totally different facts.	3
II. The Court of Appeals for the Fourth Circuit has not decided any novel or important questions and the quotations relied upon by petitioner do not indicate any such decision.	10
1. The Court decided that both labels and marks were dissimilar; the discussion of labels in no way disturbed the decision of the marks and was necessary on unfair competition.	12
2. The Circuit Court did not decide that people familiar with the trademark V-8 would have knowledge of the identity of its owner.	18
3. The Court of Appeals for the Fourth Circuit fully recognized that an owner of a trademark is entitled to protection as to source.	19
III. The conclusion that defendant's goods would be asked for as "Virginia Tomato Juice" or "Lima Beans" is sound and logical.	21
IV. Conclusion	22

TABLE OF CASES AND AUTHORITIES

Bingham v. United States, 296 U. S. 211; 56 S. Ct. 180, 80 L. Ed. 160	12
Coats v. Merrick Thread Company, 149 U. S. 562; 37 L. Ed. 847	16
Hanover Star Milling Co. v. Metcalf and Allen & Wheeler Co. v. Hanover Star Milling Co. 240 U. S. 403; 60 L. Ed. 713	4
Houston Oil Co. of Texas v. Goodrich, 245 U. S. 440; 38 S. Ct. 140, 62 L. Ed. 385	23
Jurisdiction of the Supreme Court of the United States by Robertson and Kirkham, pp. 609-611	12
M. C. Peters Mill Co. v. International Feed No. 2 Co. (C. C. A. 6) 262 F. 336, 339	17

TABLE OF CASES AND AUTHORITIES — (Continued)

	PAGE
Mishawaka Co. v. Kresge Co. 316 U. S. 203; 86 L. Ed. 1381	20
Mishawaka Co. v. Kresge Co., 6th Circuit Court's Opinion 119 Fed (2d) 316	21
Nims Unfair Competition and Trademarks, 4th Edition, Vol. 1, p. 719	17
Restatement of Torts, Sec. 728, Comment C, Sec. 720	9
Standard Brands, Inc. v. Smidler, 151 F. (2d) 34	3, 9
United States v. Johnson, 268 U. S. 220; 45 S. Ct. 496, 69 L. Ed. 925	12
Wisconsin Electric Co. v. Dunmore Co. 282 U. S. 813, 51 Sup. Ct. 214, 75 Led. 728	6

THE SUPREME COURT
of the
UNITED STATES

OCTOBER TERM 1948

No. 747

STANDARD BRANDS, INCORPORATED and
CAMPBELL SOUP COMPANY, Successor
thereto and Intervening Plaintiff,
Petitioners,

vs.

EASTERN SHORE CANNING COMPANY,
INCORPORATED,
Respondent.

BRIEF OF EASTERN SHORE CANNING COMPANY,
INCORPORATED, IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI.

FACTS

This is a suit for infringement and unfair competition
brought by Standard Brands Incorporated against East-

ern Shore Canning Company, Incorporated. The alleged infringement and unfair competition concerned the use by the defendant of the trade-mark VA on tomato juice and lima beans. Standard Brands Incorporated contended that this was an infringement of its mark V-8 used on cocktail vegetable juices.

The District Court of the United States for the Eastern District of Virginia, after a trial and oral argument of counsel, supplemented by briefs, decided that there was no infringement or unfair competition. The basis of the decision was that the marks themselves were not sufficiently alike either in appearance or meaning to cause confusion; that even in sound there was no resemblance unless the mark VA were slurringly pronounced "V-ay", and there was no evidence that the mark was pronounced in this manner; that since VA was the customary and well-known abbreviation for the State of Virginia, there was every reason to expect that the mark was pronounced "Virginia", in which event there was no resemblance even in sound.

The Court of Appeals for the Fourth Circuit affirmed this decision of the District Court, and it is from this action on the part of the Circuit Court that the petitioner asks a writ.

Petitioner had no knowledge of the use by Eastern Shore Canning Company of the mark VA until October, 1945, although Eastern Shore had used the mark since October 1941 on its lima beans, and on its tomato juice since July, 1944, in a business operated less than one hundred miles from two of petitioner's agency offices at Norfolk and Newport News. Actually, petitioner learned of the use of the mark on lima beans by means of a letter from Eastern Shore's attorneys dated February 13, 1946. (R. 16)

Petitioner does not sell lima beans or tomato juice under the trade-mark V-8, but does sell frozen lima beans and tomato juice under marks other than V-8. (R. 16)

ARGUMENT

- I. *There Is No Conflict between the Decisions of the Court of Appeals for the Fourth Circuit in the Instant Case and that of the Court of Appeals for the Second Circuit in the Smidler Case because the Cases Were Decided on Totally Different Facts.*

Appellant argues that there is a conflict between the decisions of the Court of Appeals for the Fourth Circuit in the instant case (172 F(2) 144) and the decision of the Court of Appeals for the Second Circuit in the case of *Standard Brands v. Smidler*, 151 F(2) 34, and it invokes this alleged conflict as a reason for this court's considering this case.

Let us first consider the points at issue in the two cases:

In the Smidler case, Standard Brands, Inc., the owner of the trade-mark V-8 for a combination of vegetable juices, sued the defendant Smidler who used *the identical mark* V-8 on vitamin tablets.

The court held that the defendant had infringed the plaintiff's trade-mark, and that the fact that the products upon which the identical mark was used were different, did not prevent confusion of source.

In the instant case the Court of Appeals for the Fourth Circuit had before it an entirely different question. Standard Brands has sued Eastern Shore Canning

Company for the alleged infringement of its trade-mark V-8 used on cocktail juices by the defendant's use of VA on tomato juice and lima beans. It also has alleged unfair competition.

In the Smidler case the Court of Appeals for the Second Circuit decided that the defendant, by using the same mark as the plaintiff, namely, V-8, had infringed defendant's identical mark used on a different product. In the instant case the Court of Appeals for the Fourth Circuit has decided that the trademark VA did not infringe the trademark V-8 because the two marks were so different in appearance, meaning and sound, that no likelihood of confusion existed.

It, therefore, is perfectly apparent that the decisions of the two courts are not in conflict.

The situation is not as it was in the case of *Hanover Star Milling Co. v. Metcalf* and *Allen Wheeler Co. v. Hanover Star Milling Co.* 240 U. S. 403 cited by the petitioner in page 10 of its brief.

In the Hanover case two district courts in different circuits granted temporary injunctions, and both circuit courts reversed upon grounds that went to the merits and raised fundamental questions regarding the same trademark. In this situation writs of *certiorari* were granted before final decrees, despite the general rule to the contrary.

The trademark "Tea Rose" was involved in both cases. In the Fifth Circuit the District Court granted an injunction against Metcalf, restraining him from selling flour under the name "Tea Rose". The Circuit Court reversed this decree and remanded the cause with directions to dismiss the bill.

In the Seventh Circuit the District Court granted an order restraining Hanover from using the same mark

"Tea Rose" on the sale of his flour, and the Circuit Court reversed this decree and remanded the cause for further proceedings not inconsistent with its opinion.

Very properly this Court granted the writs of *certiorara* saying that the lower courts "differed upon fundamental questions."

But no such difference exists in the situation presented to this Court by the application for a writ of *certiorari* in the instant case.

The decisions of the Court of Appeals for the Second Circuit in the Smidler case, and that of the Court of Appeals for the Fourth Circuit in the instant case, certainly do not conflict in final result for the very simple reason that they concern entirely different subject matter. In the former the court decided that the use of an identical trademark V-8 on vitamin tablets was an infringement on its use on a vegetable cocktail juice. In the latter the court decided that the use of the mark VA on lima beans and tomato juice did not infringe the use of the mark V-8 on vegetable cocktail juices, because the marks were not similar enough to cause confusion.

If the Fourth Circuit had had before it the question involved in the Smidler case, there is nothing in its opinion in the instant case to indicate that it would have decided the Smidler case differently than it was decided by the Second Circuit. And had the Second Circuit been faced with the questions involved in the instant case, there is no reason to believe that it would have decided them differently than the Fourth Circuit has.

The fact is that the two circuit courts were faced with two entirely different questions, and for this reason there could be no conflict in their decisions.

In such a situation this Court does not grant writ of *certiorari*. There is no reason for it to do so.

As is said in "*Jurisdiction of the Supreme Court of the United States*" by Robertson and Kirkham, at page 609:

"But the conflict must be real, and a writ granted because of an asserted conflict, will suffer dismissal as improvidently granted if, after argument, it appears that the asserted conflict in decisions arises from a difference in states of fact and not in the application of a principle of law."

Wisconsin Electric Co. v. Dunmore Co. 282 U. S. 813, 51 Sup. Ct. 214, 75 Led. 728.

But petitioner, despite the fact that these two cases were decided on totally different sets of facts, insists that there have been different applications of trademark principles by the two courts in reaching their decisions.

For example, on page 11 of its brief, petitioner asserts that the Second Circuit has held that the V-8 trademark rights extended to include in its coverage vitamin tablets, and that the Fourth Circuit has held that the V-8 mark did not extend to cover tomato juice or lima beans.

But the Fourth Circuit has decided no such thing. It has merely decided that the VA mark is not sufficiently like the V-8 mark to furnish any likelihood of confusion. Having reached this conclusion, as both it and the District Court very definitely did, there was no necessity for it to go any further. The matter was ended.

The Court of Appeals for the Fourth Circuit quoted the District Court's opinion with approval as follows:

"There is a marked difference in the appearance of the labels and trademarks used by the respective parties, including their background, their coloring, and the arrangement of the printed matter thereon. Even the letters, or symbols, V-8 and VA, as printed on the labels, are decidedly unlike both in form and coloring." (R. 40)

And again:

"The difference in appearance is such as to offer no suggestion that the products to which they are attached are from the same source or are put up by the same packer." (R. 41)

On the question of alleged phonetic similarity appellant insisted in the lower courts that there was such a similarity. The District Court in its findings of fact number 4 (R. 32) said:

"The only element of similarity between the trademarks V-8 and VA is in a similarity of sound when the terms are not distinctly articulated and this similarity rests on the assumption that defendant's products are referred to as the VA (vee-ay) brand instead of by the name Virginia, for which the letters VA are the accepted abbreviation. There is no evidence that defendant's products are customarily referred to as VA (vee-ay) brand * * *

It was on this ground of dissimilarity of the marks themselves, that the lower courts based their decisions. Had petitioner completed the quotation from the

Fourth Circuit's opinion at the bottom of page 11 of its brief, upon which it relies to prove that the court was deciding that the V-8 trade-mark did not extend to tomato juice and lima beans, the real meaning of the court would have been plain. The excerpt completed reads as follows:

"It is significant, as pointed out in his opinion, that V-8, as used by the plaintiff, has become associated in the public mind with a specific combination of vegetable juices; that defendant does not manufacture this product and has used its accused mark only on products which no one would mistake for the combination; and that the letters VA are customarily used as an abbreviation of the name of the state in which the defendant produces and distributes its goods, and when used in connection with defendant's name, which includes the well-known designation of a geographical subdivision of the state, would be understood as indicating the territorial origin of the product rather than the goods of a corporation of nation wide fame." (R. 42)

All that the Fourth Circuit means by this language is that all of the surrounding circumstances only confirm its decision that not only are the marks dissimilar but also the use of the marks would not tend to cause confusion.

It was pertinent to consider the use to which the mark was put because this was a suit for unfair competition as well as infringement, as we will later discuss in detail.

As pointed out by the petitioner at the top of page 12 of its brief, the Fourth Circuit clearly stated the

established Federal law on the subject as follows:

"And it is also well established that the protection which the law gives to the owner of a trade-mark is not confined to the goods upon which it has been used by the owner, but extends to products which would be reasonably thought by the buying public to come from the same source if sold under a similar mark. *Standard Brands, Inc. v. Smidler*, 2 Cir., 151 F. 2d 34, 36; *Restatement of Torts*, section 728, Comment c, section 730." (R. 42)

But it did not, as petitioner asserts, misapply that law.

It based its decision mainly on dissimilarity of the marks, but it said:

"Nevertheless, it must be borne in mind that all of the factors which enter into a case of trade-mark infringement are to be considered in determining the crucial question whether the defendant's actions are likely to lead an appreciable number of prospective purchasers to regard its goods as coming from the same source as plaintiff's, and that this question must be left to the determination of the trier of fact. *Restatement of Torts*, section 728, Comment a." (R. 42)

Petitioner argues that the reason infringement was found in the *Smidler* case and not found in the instant case is that the Fourth Circuit did not recognize that the gist of appellant's action was "confusion not as to the kind of product but as to the source of the product."

Petitioner insists on this, despite the quotation given above in which the Fourth Circuit clearly recognized that the petitioner was entitled to protection not only as to goods but as to source as well.

What petitioner refuses flatly to admit is that the action of the Fourth Circuit rests on the firm foundation of lack of similarity in the marks. This is the explanation as to why it found no infringement. The Second Circuit found infringement because the marks were identical.

We respectfully submit that there is no conflict between the two cases mentioned; that they are decided on totally different subject matter; that the Fourth Circuit has decided one question, and the Second Circuit another; that the Fourth Circuit has decided that there is not sufficient similarity between the marks V-8 and VA to cause confusion; that this question never came before the Second Circuit; and that even on the reasoning there is little or no conflict; that the Fourth Circuit has clearly recognized the principle of law that there may be confusion of source even though the marks are used on different products; and that its discussion as to the use of the marks on different products was merely ancillary to its primary decision that the marks themselves were different, and in addition was pertinent in disposing of unfair competition.

II. The Court of Appeals for the Fourth Circuit Has Not Decided Any Novel or Important Questions and the Quotations Relied upon by Petitioner Do Not Indicate Any Such Decision.

Petitioner argues that the Court of Appeals has decided three important questions under the Trademark

Act which have not been but should be settled by this Court.

Those questions are listed by the petitioner as follows:

1. In deciding whether the accused mark is a 'colorable imitation' of the mark alleged to be infringed, should the court take into consideration the accessories used with the accused mark such as the name of the defendant on the label and the appearance of the label?

2. Is there any basis in law or common knowledge for a finding that people familiar with the trademark alleged to be infringed have knowledge of the identity of the owner thereof and would not be confused by the accused mark unless they thought it indicated the goods of a party of that identity?

3. Is it significant that the defendant's kind of goods would not be mistaken for the plaintiff's kind of goods in a case where the goods of the parties are related but not identically the same?

In support of the statement that the Court of Appeals for the Fourth Circuit has decided the questions propounded above, petitioner lifts from the opinion paragraphs, and portions of paragraphs and asserts that the statements made therein indicate a decision of these questions. Actually the Court of Appeals for the Fourth Circuit decided only one point in this case, and that was that VA and V-8 were not sufficiently similar to constitute either infringement or unfair competition.

At best what petitioner has done is to isolate certain portions of paragraphs, remove them from the context of the main body of the opinion, and argue that new rules have been promulgated.

The result of this has been to distort the true meaning of the lower court.

Nor do we think that these isolated statements are properly or customarily sufficient to warrant the granting of a writ of *certiorari*.

"Emphatically, the use that the court has made of its descretionary jurisdiction on *certiorari* to correct error does not destroy its general rule that it will not grant the writ merely to review evidence and discuss particular facts, nor sanction the view that claim of error may be predicated on points merely 'lurking in the record' and not presented or decided below." "Jurisdiction of the Supreme Court of the United States" Robertson and Kirkham, page 611; *United States v. Johnson*, 268 U. S. 220, 45 S. Ct. 496, 69 Led. 925; *Bingham v. United States* 296 U. S. 211, 56 S. Ct. 180, 80 Led. 160.

However, we shall proceed to discuss each of these questions in the order they were presented in petitioner's brief.

1. The Court decided that both labels and marks were dissimilar: the discussion of labels in no way disturbed the decision on the marks and was necessary on unfair competition.

Under its heading 1, on page 17 of its brief, petitioner asserts that the court has taken into consideration the accessories used with the accused mark such as the name of the defendant on the label, and the appearance of the label as a whole.

Petitioner quotes a portion of a paragraph from the opinion of the Court of Appeals as follows:

“* * * the letters VA are customarily used as an abbreviation of the name of the state in which the defendant produces and distributes its goods, and when used in connection with the defendant's name, which includes the well known designation of a geographical subdivision of the state, would be understood as indicating the territorial origin of the product * * *” (R. 42)

Petitioner says “the court resorted to the defendant's name, one of the accessories used by the defendant in connection with the accused mark, in order to find that the accused mark conveys a geographical meaning and indicates territorial origin instead of commercial origin.” (p. 17 petitioner's brief)

But there was not the slightest necessity for the court to resort to the name of the defendant company in order to “find that the accused mark conveys a geographical meaning * * *”. The mark VA itself is the well-known abbreviation of the State of Virginia, and this is sufficiently geographic to indicate territorial origin instead of commercial origin.

At most, the reference to the name of the defendant only made more specific the reference to the exact part of Virginia in which the defendant produced and distributed its goods.

If it were error for the court in this case to refer to the name of the company as more specifically indicating the exact geographical origin of the goods, it was harmless error. We do not believe it to be error at all for the reasons we shall hereinafter give.

Petitioner next states that the accused mark must stand on its own feet and be sufficiently different in itself from the petitioner's trademark to avoid confu-

sion.

With this statement we have no quarrel if it is limited to infringement and not applied to unfair competition also.

But we submit that defendant's mark is sufficiently different in itself from petitioner's mark to avoid confusion.

While two courts have carefully examined these marks and decided that they were not confusingly similar, we point out that the lettering of the word VA is in large wide block letters, orange in color. The right prong of the V extends very much further up than the normal V. The V in V-8 is in large narrow letters, black on a green background, without any difference in the length of the prongs.

And in this connection we further comment that the illustrations in petitioner's brief of the two marks are not in color and do not properly convey the striking color differences in the marks themselves. Resort should be made to the exhibits themselves to appreciate the true differences.

On page 18 of its brief, petitioner cites a series of cases holding that the mere fact that a defendant inserts its name on a label does not prevent infringement if the marks are sufficiently alike to otherwise constitute infringement. These cases have no pertinency to the present discussion. The Circuit Court did not base its decision that the marks in the instant case were not confusingly similar on the fact that defendant's name appears on the label, and nowhere in the opinion does it say that its decision was based on this ground.

Petitioner quotes the finding of the District Judge on the marked dissimilarity of both labels and marks used by the two parties in this suit. The Circuit Court

quoted this finding with approval in its opinion (R. 40). Petitioner maintains that since the District Judge has in this finding described the marked differences in the labels, that he is resorting to the accessories to distinguish the marks. The short answer to this would be that both the District and Circuit courts found not only the labels but also the marks themselves totally dissimilar.

But there is another explanation for the references to the labels in the two opinions.

Petitioner brought its actions not only on alleged infringement but also on alleged unfair competition. Paragraphs IV, X and XII of its complaint read as follows: (R. 1 and 3)

"IV. This is an action arising under the trademark laws of the United States, Act of February 20, 1905, for infringement of a trademark registered in accordance with the provisions of the said Act, and also an action for unfair competition.

X. Since a date subsequent to the sale of plaintiff's V-8 Vegetable Juices in the State of Virginia and elsewhere in interstate commerce, defendant has been canning and selling tomato juice and lima beans under the trademark VA in competition with the plaintiff in the State of Virginia and elsewhere in interstate commerce. A specimen of defendant's VA Tomato Juice label is hereto attached and marked "Exhibit B to the complaint" and a specimen of defendant's VA Lima Beans label is hereto attached and marked "Exhibit C to the complaint".

XII. By its acts aforesaid defendant is likely to confuse and deceive purchasers and cause them

to believe that defendant's tomato juice and lima beans come from the same source as V-8 Vegetable Juices; and defendant is infringing plaintiff's trademark V-8 and unfairly competing with the plaintiff." (R. 1-4)

The complaint closed with a demand that defendant be directed to deliver up for destruction any and all labels, containers, etc. (R. 4).

There has never been any amendment of this complaint.

The stipulation of facts, signed by attorneys for both parties, describes this suit as follows:

"This is a civil action for trademark infringement and unfair competition * * *" (R. 10)

While it is true that in its brief in the Circuit Court and in its petition for *certiorari* petitioner stated, for purposes of its own argument, that the only unfair competition involved was infringement, yet it did not so limit the charge of unfair competition in its pleading, and even if it had the situation would not have been changed. The charge of unfair competition would still have been before the court necessitating the consideration of all of the circumstances including the labels in a determination as to whether unfair competition existed. This court had before it a similar situation in the case of *Coats v. Merrick Thread Company*, 149 U. S. 563, 37 Led. 847, where the unfair competition alleged consisted of infringement. Nevertheless this court carefully considered the labels and other accessories in disposing both of infringement and unfair competition.

It is well settled that there must be a consideration of labels in determining the issue of unfair competition.

“The rule that labels and packages play no part in the determination of trade-mark infringement has had wide acceptance but its application is not always clear. The confusion probably is due to the close relationship of trade-mark infringement to unfair competition. A large percentage of actions for trade-mark infringement include causes of action for unfair competition. Usually, also, the issues of trade-mark infringement and of unfair competition are so closely allied that their separate discussion is difficult and unnecessary. A decision in such a case may read as though all the facts were determinative of both issues, as though evidence with regard to labels and packages had entered into the decision of the question of technical trade-mark infringement.” Vol. 1 *Nim’s Unfair Competition and Trademark*, 4th Ed. bottom p. 719.

In *M. C. Peters Mill Co. v. International Feed No. 2 Co.* (CCA6) 262 F. 336, 339, the court said: —

“As a general rule, the right to recover upon either of these causes of action depends, substantially, upon the same state of facts, excepting, of course, the statutory provisions applying to trade-marks, and excepting also, that in disposing of the question of unfair competition, a court should take into consideration the dress, combination of colors, and manner and method of application and use of the respective marks.”

We, therefore, respectfully submit that the court in this case has decided that the marks themselves are so dissimilar as not to infringe; that the discussion of the

dissimilarity of the labels has in no way disturbed the conclusion; that a discussion of the labels is pertinent in regard to unfair competition, which petitioner has itself injected into this action.

2. The Circuit Court did not decide that people familiar with the trademark V-8 would have knowledge of the identity of its owner.

Petitioner takes the last clause from an excerpt from the opinion and places an interpretation thereon which the Circuit Court did not intend and which does not follow at all when the whole context is considered. The excerpt reads as follows:

“* * * the letters VA are customarily used as an abbreviation of the name of the state in which the defendant produces and distributes its goods, and when used in connection with defendant's name, which includes the well-known designation of a geographical subdivision of the state, would be understood as indicating the territorial origin of the product *rather than the goods of a corporation of nationwide fame.*” (R. 42) (1)

Petitioner says that the reference to Standard Brands as a “corporation of nationwide fame” is a finding that people familiar with V-8 have knowledge of the identity of the owner of the trademark V-8.

But this is not even what the court was discussing. It was merely emphasizing that VA was an abbreviation of a state name, a geographical term and that to the average purchaser it indicated that the product came from Virginia, and did not indicate that it was a product of Standard Brands or of any other corporation of na-

tionwide fame.

It was a simple assertion that VA was a term geographical in nature without any indication that it connoted a product of any particular corporation. For the phrase "a corporation of nationwide fame" might have been substituted the words "any particular corporation" and the meaning might have been clearer.

Petitioner here has simply misunderstood the meaning of the court. There is no basis for the claim that the court here has decided an important question upon which there is authority to the contrary.

3. The Court of Appeals for the Fourth Circuit fully recognized that an owner of a trademark is entitled to protection as to source.

Petitioner attempts in its argument, beginning on page 23 of its brief, to infer that the Court of Appeals for the Fourth Circuit did not recognize the well known law that a trademark owner is entitled not only to protection from a confusion of goods but also to protection as to source or origin of the goods.

Perhaps the best answer we can give to this contention is to refer again to the clear statement in the opinion of the Circuit Court recognizing this principle of Trademark law (R. 42).

Not only did the Circuit Court have it in mind but the District Court also clearly appreciated it. It said in its opinion after discussing the dissimilarities of both the labels and marks

"The difference in appearance is such as to offer no suggestion that the products to which they are attached are from the same source or are put up by the same packer". (R. 25).

It is, of course, true that since the instant suit involved both infringement and unfair competition, both the District and Circuit Courts discussed the difference in products at considerable length. The use to which the respective marks have been put is vital in determining unfair competition.

Petitioner cites the case of *Mishawaka Co. v. Kresge Co.*, 316 U. S. 203, on page 25 of its brief to sustain its position that in that case no opinion had been expressed by the court on the question as to the materiality of confusion of products in determining likelihood as to confusion of source or origin.

That case graphically illustrates why a writ of *certiorari* should not be granted in the instant case.

There a writ was granted by this Court from the Sixth Circuit. The writ was requested on two grounds. First the petitioner complained that full relief had not been given it on the question of infringement. The lower courts had determined that petitioner was entitled to an injunction and damages on account of the use of a mark consisting of a red rubber ball imbedded in a rubber heel. But relief was denied the petitioner for the alleged infringement by the use of other discs in various forms and designs in the rubber heels. Petitioner claimed infringement as to these other marks and in its petition asked the consideration of this point by this court.

Secondly, it asked a writ on the ground that even as to the infringement which the lower courts had held to exist, the proper method of accounting to determine damages had not been followed by the Circuit Court.

This Court granted the writ solely on the accounting question but flatly refused it on the infringement question saying that that question was not open in this

Court (86 Led. 1384; 316 U. S. 205).

A reading of the opinion of the Sixth Circuit, reported in 119 Fed. (2d) 316, shows that many of the same questions on infringement now relied upon in the instant case for the granting of a writ were concerned there. Yet the Court there refused a writ on these same questions.

That case like the instant case concerned a suit for infringement and unfair competition; and in that case, as in the instant case, there was a discussion of the effect of a difference in the goods upon the likelihood of confusion; and of the dissimilarities of the labels; and, in that case as in the instant case, the court held that there was no sufficient similarity in either the labels or trademarks to constitute either infringement or unfair competition.

We submit that petitioner's own authority, cited by it on other points, shows that no writ should be granted in the instant case.

III. The Conclusion that Defendant's Goods Would Be Asked for as "Virginia Tomato Juice" or "Virginia Lima Beans" Is Sound and Logical.

Petitioner argued vainly in both lower courts that the mark VA would be pronounced by a prospective purchaser "Vee-ay", and not "Virginia", for which the letters VA are the well-known State abbreviation.

Only on the assumption that the mark is pronounced "Vee-ay" could there be the slightest claim of phonetic similarity. If it be pronounced "Virginia", as we have contended, there can be no phonetic similarity — and added to the lack of similarity of appearance and meaning, would be a dissimilarity in sound.

Yet petitioner in the lower courts on this point so vital to his case, produced not a word of evidence. Petitioner excuses this weakness by saying that the facts were stipulated to save expense. But that did not prevent the introduction of evidence on the point, if there were any such evidence. The burden certainly rested on the petitioner, and not on this respondent to produce this evidence.

To us it seems perfectly clear that to the ordinary purchaser the abbreviation "VA" means Virginia. He would not normally pronounce it "V-ay" accentuating the separate letters. He would pronounce it "Virginia" just as he would pronounce "MD" as "Maryland", not "MD", which might connote a medical degree. So also with any State abbreviation, such as "GA" for "Georgia", "CAL" for "California".

The situation is quite different in regard to the "VA" mark where one letter follows another without any sign of hesitation or separation, and that which exists in regard to the "V-8" mark where the connecting mark very definitely requires the pronunciation separately of the letter and numeral.

But petitioner says that the mark pronounced "Virginia" would be quite valueless to this respondent. That conclusion does not follow. As pointed out by the District Court (R. 22) practically all of defendant's marks are geographical, either referring to Virginia or to Eastern Shore in one form or another. Yet these marks, although indicating mere geographical locations, have proved quite satisfactory to the petitioner.

IV. Conclusion.

This case has been decided by two lower courts in

favor of the respondent. While the facts were stipulated, yet the vital question as to confusing similarity of the two marks was in itself largely a question of fact.

Of course, the jurisdiction of this Court is largely discretionary. Yet, it is submitted, due consideration should be given to the fact that petitioner has received two full trials of its contentions, and that two courts have concurred in rejecting them. *Houston Oil Co. of Texas v. Goodrich*, 245 U. S. 440, 38 S. Ct. 140, 62 L. Ed. 385.

Then, too, in the last analysis the writ is granted in non-conflict cases, such as the instant case, on the ground of importance. The instant case presents no novel or important questions. It is a simple, run-of-the-mine trademark case where two courts using their best judgment have decided there is no confusing similarity, in the respective marks, a conclusion with which petitioner simply does not agree.

We respectfully ask that the writ be denied.

GEORGE M. LANNING,
BENJAMIN W. MEARS,
BARRON F. BLACK,
Counsel for Respondent.

Norfolk, Virginia